

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of Joffre Baker et al. Serial No.: Unassigned Filed: June 29, 2001 For: CARDIAC HYPERTROPHY FACTOR AND USES THEREFOR	Group Art Unit: Unassigned Examiner: Unassigned EXPRESS MAIL LABEL NO. EM 168 886 555 US DATE OF DEPOSIT: June 29, 2001
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PRELIMINARY AMENDMENT

Assistant Commissioner of Patents
Washington, D.C. 20231

Sir:

The instant application is filed on or before July 3, 2001 which is within the pendency of U.S. Application Serial No. 09/033,114 of which the instant application is a continuation. Prior to examination of the above-identified accompanying application please amend the application as follows.

In the Specification:

Please replace the paragraph beginning on page 1, line 17, with the following rewritten paragraph:

--The application makes reference to, and claims the benefits available under 35 U.S.C. Section 120 of, copending U.S. Ser. No. 09/033,114, filed March 2, 1998, which is a continuation of Serial No. 08/733,850 filed on October 18, 1996 (now abandoned), which is a continuation of Serial No. 08/443,129 filed May 17, 1995, now U.S. Patent No. 5,627,073 issued May 6, 1997, which is a divisional of Serial No. 08/286,304 filed August 5, 1994, now U.S. Patent No. 5,571,893 issued November 5, 1996, which is a continuation-in-part of Serial No. 08/233,609 filed April 25, 1994, now U.S. Patent No. 5,534,615 issued July 9, 1996, which applications are incorporated

herein by reference and to which application priorities are claimed under 35 USC §120.--

In the Claims:

Cancel claims 1-30 without prejudice to later prosecution in a continuing application and add the following new claims.

--31. A method of increasing survival of a neuron, comprising administering a survival-promoting amount of cardiotrophin-1 to the neuron.

32. The method of claim 31, wherein the neuron is a peripheral nervous system neuron.

33. The method of claim 32, wherein the neuron is a ciliary ganglion.

34. The method of claim 32, wherein the neuron is a motor neuron.

35. The method of claim 31, wherein the increasing survival treats a neurological disorder.

36. The method of claim 35, wherein the disorder is a peripheral neuropathy.

37. The method of claim 36, wherein the disorder is a peripheral neuropathy of a motor neuron.

38. The method of claim 36, wherein the disorder is a peripheral neuropathy of a parasympathetic neuron.

39. The method of claim 38, wherein the neuron is a ciliary ganglion.

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38. The method of claim 35, wherein the neurological disorder is caused by trauma.

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59. The method of claim 31 further comprising administering a therapeutically effective amount of a second neurotrophic factor.

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40. The method of claim 39, wherein the second neurotrophic factor is selected from the group consisting of IGF-1, CNTF, NGF, BDNF, NT-3, and NT-4.--

REMARKSFormal MattersIn the Specification:

Applicants have amended the first paragraph of the specification to include the U.S. Patent Numbers of applications 08/443,129, 08/286,304 and 08/233,609 and to correct the status of application '850 as now abandoned and application '304 as a CIP of '609.

In the Claims:

Claims 31-45 are pending in the application.

Support for the new claims is found throughout the specification such as at page 3, line 28 to page 4, line 3; page 4, lines 8-9; page 24, line 19 to page 25, line 12; page 30, lines 23-30; page 73, lines 12-16; page 74, lines 13-19; page 74, line 29 to page 75, line 10; page 107, line 28 to page 108, line 30 (Example IV).

No new matter is added by the amendments to the specification or the claims.

The claims are amended merely to focus the issues on prosecution. Applicants retain the right to prosecute in other applications the full scope of the subject matter of the invention as originally filed.

Priority

In order to expedite prosecution of the instant application, Applicants respectfully point out that they should receive the benefit of an earlier filing date under 35 U.S.C. § 120 corresponding to the filing date of the '609 parent application since the '609 application discloses and enables the instant invention.

Support for the new claims is found throughout the '609 parent application at, for example, page 3 line 30 to page 4, line 8; page 4, lines 13-14; page 25, line 24 to page 26, line 20; page 31, line 28 to page 32, line 2; page 78, line 21 to page 79, line 32; and page 112, line 25 to page 113, line 30 (Example IV). This supporting

language in the '609 parent application corresponds to the supporting language recited above in the instant continuation application.

SUMMARY

Applicants have amended the specification to make current the status of the applications in this series. No new matter is added by these amendments.

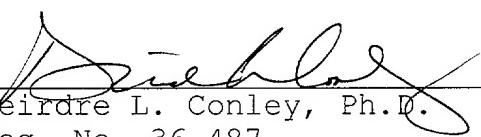
Claims 1-30 have been canceled without prejudice to later prosecution and new claims 31-45 have been added. Applicants' discovery that cardiotrophin-1 increases the survival of neurons is disclosed in the instant application. Applicants' newly added claims recite methods of using cardiotrophin-1 for increasing the survival of a neuron by administering cardiotrophin-1 to a population of neurons. Support for the new claims is found throughout the specification as recited above. No new matter is added by the addition of the new claims.

Allowance of the claims is respectfully requested.

If in the opinion of the Examiner, a **telephone conference** would expedite the prosecution of the subject application, the Examiner is **strongly encouraged** to call the undersigned at the number indicated below.

Respectfully submitted,
GENENTECH, INC.

Date: June 29, 2001

By: 
Deirdre L. Conley, Ph.D.
Reg. No. 36,487



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PATENT TRADEMARK OFFICE

PC Docs #92888

VERSION WITH MARKINGS TO SHOW CHANGES MADEIn the specification:

Paragraph beginning at line 17 of page 1 has been amended as follows:

This application makes reference to, and claims the benefits available under 35 U.S.C. Section 120 of, copending U.S. Ser. No. 09/033,114, filed March 2, 1998, which is a continuation of Serial No. 08/733,850 filed on October 18, 1996 (now abandoned), which is a continuation of Serial No. 08/443,129 filed May 17, 1995, now U.S. Patent No. 5,627,073 issued May 6, 1997, which is a divisional of Serial No. 08/286,304 filed August 5, 1994, now U.S. Patent No. 5,571,893 issued November 5, 1996, which is a continuation-in-part of Serial No. 08/233,609 filed April 25, 1994, now U.S. Patent No. 5,534,615 issued July 9, 1996, which applications are incorporated herein by reference and to which application priorities are claimed under 35 USC §120.

In the claims:

Claims 1-30 have been cancelled. New claims 31-40 have been added.

Clean Copy of the Pending Claims

31. A method of increasing survival of a neuron, comprising administering a survival-promoting amount of cardiotrophin-1 to the neuron.
32. The method of claim 31, wherein the neuron is a peripheral nervous system neuron.
33. The method of claim 32, wherein the neuron is a ciliary ganglion.
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39. The method of claim 38, wherein the neuron is a ciliary ganglion.
38. The method of claim 35, wherein the neurological disorder is caused by trauma.
39. The method of claim 31 further comprising administering a

therapeutically effective amount of a second neurotrophic factor.

40. The method of claim 39, wherein the second neurotrophic factor is selected from the group consisting of IGF-1, CNTF, NGF, BDNF, NT-3, and NT-4.

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